UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Paper No. 3

PATRICK J. COYNE
COLLIER, SHANNON, RILL AND SCOTT, PLLC
3050 K STREET, N.W.
WASHINGTON, D.C. 20007

In re Application of:
Stuart A. Newman
Application No. 08/993,564
Filed: December 18, 1997
For: CHIMERIC EMBRYOS AND ANIMALS CONTAINING HUMAN CELLS

ON PETITION

This is a decision on the communication filed February 27, 1998, and supplemented April 24, 1998, which seeks treatment: (1) under 37 CFR 1.182, as a request for an advisory opinion regarding "a clarification of policy from the Commissioner regarding the patentability of cloned or genetically modified human embryos," or, in the alternative, (2) under 37 CFR 1.291, "relative to any application by Dr. Ian Wilmut...that may be pending in the U.S.P.T.O." The communication filed on February 27, 1998 will not be treated as a protest for the reasons indicated below.

The petition under 37 CFR 1.182 is dismissed.

While the instant communication is styled as a petition, the communication requests an advisory opinion from the Patent and Trademark Office (PTO). It is not the practice of the PTO to render advisory opinions. See Malone v. Toth, Rupp, and Meyer, 202 USPQ 397 (Comm'r Pat. 1978). Furthermore, a petition may not be employed for the purpose of requesting an advisory opinion. Id.

The term "patentability" relates more to appealable subject matter, than petitionable subject matter. As explained in the Manual of Patent Examining Procedure (MPEP § 1201)[1]:

> "The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which

[1] Rev. 3, 6th. Ed. (July 1997).

> the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.
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> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter."

PTO's long-established policy is to maintain a line of demarcation between petitionable and appealable subject matter. The Commissioner will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

It would clearly be inappropriate to issue a general statement in a decision on petition, as to the patentability of an entire class of claims in the abstract. Rather, the patentability of any invention, or more properly, the patentability of the claims drawn to that invention, would depend upon the metes and bounds of the claims at issue, construed in light of the accompanying specification, and considered under Title 35 of the United States Code. Since Congress has provided, in the patent statute, a specific scheme for consideration of "patentability" questions, the creation of other schemes (*e.g.*, by way of 37 CFR 1.182 or 1.183) for the consideration of the same issues would be inconsistent with the patent statute. The avenue for consideration and review of any "patentability" issues that might arise in this application during examination is amply provided for by Chapter 12 of Title 35, United States Code, and the corresponding promulgating regulations.

With respect to treatment under 37 CFR 1.291:

Inspection of the instant communication reveals that petitioner has not complied with the requirements of 37 CFR 1.4(b) and (c).

In particular, a petition directed to the present application may not be combined with a protest directed to another application in a single letter to the Office.

Petitioner should note that a protestor will not receive any correspondence from the Office relating to a protest. See 37 CFR 1.291(c) and MPEP § 1901.05.

This application file is being forwarded to Technology Center 1600.

Telephone inquiries concerning this decision may be directed to Special Projects Examiner Brian Hearn at (703)305-1820.

Abraham Hershkovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects